

REMARKS

These remarks are responsive to the Final Office Action of April 18, 2005. A request for continued examination is being filed herewith. Claims 1-3, 5-7, 9, 11 and 12 are pending. Applicant appreciates the indication of allowable subject matter. Specifically, claim 5 is objected to as being allowable if rewritten in independent form. Claim 12 is allowed. Reconsideration and allowance of the instant application are respectfully requested.

I. Declaration Under Rule 1.132

Applicant submits herewith a Declaration under Rule 1.132 to obviate the alleged obviousness of the noted rejected claims. In particular, the Declaration addresses the significant commercial success obtained by the commercial embodiment of the plastic profile recited at least in claim 1. The evidence of the significant commercial success is provided in the attached Declaration.

II. Claims 1-3, 6, 7, 9 and 11 are Allowable

In the Office Action, claims 1-3, 6, 7, 9 and 11 were rejected under 35 U.S.C. §103(a) by WO 01/17411 to Tavivian (Hereinafter WO '411) generally as a matter of design choice.

Claim 1 recites in-part that the profile includes a flexible middle segment having (1) an operating life in excess of 10,000 bend cycles; (2) a tensile strength of about 2750 lbs/sq. in. and (3) an elongation of about 350%. WO '411 does not disclose that its middle segment includes a flexible material having each of these elements. It was asserted in the Final Office Action that the profile recited in the claim 1 would have been obvious to one of ordinary skill in the art. Case law discussing the optimization of result effective variables was cited in the Office Action to support the conclusions reached by the Examiner.

This is not a case of a mere optimization of result effective variables to arrive at the recited profile. The applied reference (WO '411) **does not** disclose any one of the operating life, tensile strength and percent elongation. Hence, there can not be any teaching of optimization of the recited features. When evaluating patentability under 35 U.S.C. § 103(a), all claim features must be considered, **especially when they are missing from the prior art.** *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988) (Federal Circuit held a reference did not render the claimed combination obvious because the examiner ignored a claimed feature that was absent from the reference). Furthermore, the reference is completely devoid and does not disclose the specific combination of these elements recited in claim 1 or why one of ordinary skill in the art would arrive at this specific combination of elements. In view of the foregoing reasons, claim 1 is allowable and the dependent claims 2, 3, 6, 7, 9 and 11 for further features recited therein.

III. The Claimed Invention is Not Obvious In Light of Commercial Success

To decide questions of obviousness under 35 U.S.C. § 103, the Supreme Court identified in *Graham v. John Deere Co.*, 383 U.S. 1 (1966) several factual inquiries, including objective evidence of non-obviousness (secondary considerations). With this backdrop, the invention must then be evaluated as a whole. *Gillette Co. v. S.C. Johnson & Son, Inc.* 919 F.2d 720, 724 (Fed. Cir. 1990).

A. The Objective Evidence of Non-Obviousness is Overwhelming

[O]bjective evidence such as commercial success, failure of others, long-felt need, and unexpected results **must** be considered before a conclusion on obviousness is reached. Indeed, [such] **“evidence of secondary considerations may often be the most probative and cogent evidence of record.”** It may often establish that an invention appearing to have been obvious in light of the prior art is not.”

Minnesota Mining and Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc., 976 F.2d 1559, 1573 (Fed. Cir. 1992) (citations omitted) (emphasis added) (quoting, *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538 (Fed. Cir. 1983)).

The rationale for giving weight to the so-called “secondary considerations” is that they provide objective evidence of **how the patented device is viewed in the market place, by those directly interested in the product.**

Demaco Corp. v. Von Langsdorff Licensing Ltd., 851 F.2d 1387, 1391-92 (Fed. Cir.)(emphasis added), *cert. denied*, 488 U.S. 956 (1988). The real world evidence, as provided in the Declaration of Mr. Travivian (the inventor), demonstrates the significant commercial success and acceptance in the marketplace of the inventive plastic profile.

1. The Invention Satisfied a Long Felt Need for a Solution to Problems of the Previous Plastic Profile Designs

The inventive plastic profile of the instant application solved the problems with the prior profiles. The prior profiles were not accepted in the marketplace and had many customer complaints. (See Travivian Dec., para. 3). From September 1999 to December 2002, the company manufactured 1,500 enclosures with the prior profiles, but only 300 units were sold during that period. Additionally, the company had many complaints about the product of the

previous profile discussed in WO '411. (See Travivian Dec., para. 3). The objective evidence provides that the inventive profiles have demonstrated a commercial success of increase of about 1,900% over the previous profile design.

2. The Inventive Plastic Profile Has Experienced Great Commercial Success and Acceptance

The commercial success and market acceptance of the inventive profile of the instant application is demonstrated by his company's sales of the product. The recited profile was introduced in the market in January 2003 and has sold more than 6,000 units with the shower enclosure verses merely 300 units of the previous design. (See Travivian Dec., para. 3-6). The commercial success and market acceptance of the inventive plastic profile is clearly demonstrated by the substantial evidence that the MTD Industries, Ltd. is producing another 10,000 units of the product with the inventive plastic profile for sale in the marketplace. (See Travivian Dec., para. 6). Hence, the inventive plastic profile has had a monumental increased success of 16,000 units of production since its introduction into the marketplace. Further "[i]n the year 2003 alone, more shower enclosures with these flexible hinges were sold than the entire amount sold between 1999 and 2002 of the earlier series." (Travivian Dec., para. 5).

The nexus between the attributes of the inventive plastic profile, and the staggering commercial success and other objective indicia of nonobviousness, is established in part, by the evidence that company had to replace the prior minimally sold profiles for existing clients with the new profile series. (See Travivian Dec. para. 5). The inference of nexus between the commercial success and the inventive profile also arises from MTD Industries, Ltd. of experience in the relevant market prior to its development of the new plastic profile, combined with its high sales of the new plastic profile. (See Travivian Dec. 3-6)

3. The Overwhelming Objective Evidence of Non-Obviousness Rebutts Any alleged *Prima Facie* Obviousness

The Court of Appeals for the Federal Circuit has stressed that before reaching a conclusion of obviousness, the invention must be considered as a whole, which must particularly include a proper consideration of the objective indicia of non-obviousness. Indeed, the Court has opined on many occasions that an invention that might otherwise appear obvious, nevertheless requires a conclusion of **non**-obviousness, in the face of strong objective indicia. *Demaco Corp.*, 851 F.2d at 1391; *Simmons Fastener Corp. v. Illinois Tool Works, Inc.*, 739 F.2d 1573, 1575-76 (Fed. Cir. 1984), *cert. denied*, 471 U.S. 1065 (1985).

With this in mind, Mr. Travivian is the inventor in **both** the instant application and WO 01/17411. He has expressly stated that the specification of WO '411 does not disclose or suggest a flexible, hinged panel connector that flexes in a first swivel direction and a second, opposite swivel direction as recited in claim 1. Therefore, it is submitted that one of ordinary skill would not have been motivated to modify the profile disclosed in WO '411 to include a more flexible middle segment with the recited features. Further, the second sense of swivel was not contemplated in the WO '411 disclosure. In view of the commercial success and other factors, withdrawal of the rejections is requested.

Conclusion

For all of the foregoing reasons, it is respectfully submitted that application is in condition for allowance. Should the Examiner believe that anything further is desirable in order to place the application in even better form for allowance, the Examiner is respectfully urged to

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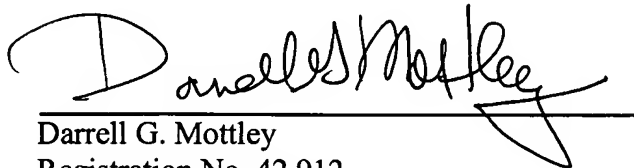
contact applicants' undersigned representative at the below-listed number. If any additional fees are required or if an overpayment has been made the Commissioner is authorized to charge or credit Deposit Account No. 19-0733.

Respectfully submitted,

BANNER & WITCOFF, LTD.

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